

The Examiner, of course, is charged with the initial burden of establishing a prima facie basis to deny patentability to a claimed invention under any statutory provision. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Indefiniteness under the second paragraph of 35 U.S.C. §112 is a question of law. *Zoltek Corp. v. United States*, ___ F.3d ___, 57 USPQ2d 1257 (Fed. Cir. 2000); *Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. §112, the Examiner is charged with the initial burden, of providing a basis in fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art, with the supporting specification in hand, would not be able to reasonably ascertain the scope or protection defined by a claim. *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). Consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. §112. *Zoltek Corp. v. United States*, supra; *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *U.S. v. Telectronics Inc.*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986). Applicants stress that a patent specification is directed to one having ordinary skill in the art and that claims are read in light of and consistent with

the supporting specification. *Zoltek Corp. v. United States*, supra; *Miles Laboratories, Inc. v. Shandon, Inc.*, supra.

In applying the above legal tenets to the exigencies of this case, Applicants submit that the Examiner did not establish a prima facie basis to deny patentability to claimed invention under the second paragraph 35 U.S.C. §112, and that one having ordinary skill in the art would have no difficulty understanding the scope of the claims, particularly when reasonable interpreted **in light of and consistent with** the supporting specification.

Specifically, claims 2 through 7 do, in fact, restrict the method of claim 1 by requiring the **use** of specific materials. Furthermore, claim 7 is definite in reciting that a cooling medium is used. The Examiner is requested to provide a legal basis upon to support the position that the invention defined in claim 7 would have confused one having ordinary skill in the art by excluding a cooling medium. In this respect, the Examiner's attention is invited to the negative limitation "essentially free of alkaline metal" in the application involved in *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983). Moreover, Applicants are free to define that what they regard as their invention under 35 U.S.C. §112. *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979); *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970).

Based upon the foregoing, Applicants submit that the Examiner did **not** establish a prima facie basis to deny patentability to claims 2 through 7 under the second paragraph of 35 U.S.C. §112. Moreover, one having ordinary skill in the art would have no

difficulty understanding the scope of the claimed invention when reasonably interpreted in light of and consistent with the supporting specification. *Zoltek Corp. v. United States, supra*. Applicants, therefore, respectfully submit that the imposed rejection of claims 2 through 7 under the second paragraph of 35 U.S.C. §112 is not legally viable and, hence, solicit withdrawal thereof.

Claim 1 was rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Sucarrats.

In the statement of the rejection, the Examiner asserted that Sucarrats discloses a method corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.* ___ F.3d ___, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing a rejection under 35 U.S.C. §102, the Examiner is required, as a matter of procedural due process of law, to identify wherein an allegedly anticipating reference identically discloses each feature of the claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant difference between the method defined in independent claim 1 and the method

disclosed by Sucarrats that scotch the factual determination that Sucarrats identically describes the claimed invention within the meaning of 35 U.S.C. §102.

Specifically, independent claim 1 requires the manipulative step of "forming a continuous flaw on at least one surface of a ceramic sintered base plate from end to end....". It is **not** apparent, and the Examiner has **not** identified, as required consistent judicial precedent, wherein Sucarrats discloses or even suggests a method for applying a continuous flaw on at least one surface of a "ceramic sintered base plate from end to end using a flawing tool" as claimed. Indeed, it is not apparent and the Examiner has not even identified wherein Sucarrats discloses a sintered base plate in the first place. *In re Rijckaert, supra.; Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.*

The above argued difference between the claimed invention and the method of Sucarrats undermines the factual determination that Sucarrats identically describes the claimed invention within the meaning of 35 U.S.C. §102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).* Applicants, therefore, respectfully submit that the imposed rejection of claim 1 under 35 U.S.C. §102 for lack of novelty as evidenced by Sucarrats is not factually viable and, hence, solicit withdrawal.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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